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| 22850 7590 06/06/2007<br>OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.<br>1940 DUKE STREET<br>ALEXANDRIA, VA 22314 |             |                      | EXAMINER<br>CHAMPAGNE, DONALD   |                             |
|  |             |                      | ART UNIT<br>3622                | PAPER NUMBER                |
|  |             |                      | NOTIFICATION DATE<br>06/06/2007 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary**

Application No.

10/751,429

Applicant(s)

SEET ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 and 31-33 is/are rejected.
- 7) ☒ Claim(s) 28-30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 17 Nov 2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 4 and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. At the third line from the end of each claim, "an imaginary dividing line" is new matter. Said line is clearly visible in any open book (at the center of the spine), and, for example in Fig. 1B of the instant disclosure. There is nothing "imaginary" about it.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11-20, 29, 30, 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 11 and 20 each recite the limitation "said electronic book" in line 3. There is insufficient antecedent basis for this limitation in the claims.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 7-14 and 16-27 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho (US005909207A) in view of the admitted prior art (para. [0025]-[0029])

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and Fig. 14 of the published application, US 20040138952A1) and further in view of Treyz et al. (US006587835B1).

7. Ho teaches (independent claims 1, 11 and 20) a method and system for electronically inserting advertisement into displayed content of an electronic book, and a computer program product containing said method, the method comprising steps of:

organizing sequentially content of said electronic book into portions corresponding to more pages than what are simultaneously viewed on a single display (col.1 lines 23-25);

dividing said content including said advertisement (para. 8 below) into a plurality of discrete content amounts, displaying at least two of said discrete content amounts on said single display, at least one of said two discrete amounts including said advertisement, said content including said advertisement embedded on a page that is displayed on said single display (col. 17 lines 16-32 and Figs. 6A and 6B); and

advancing to a selected discrete content amount other than said at least two discrete content amounts, wherein

said advancing step comprises

displaying at least two pages simultaneously flipping across from at least one of book right-side to the book left-side and from the book left-side to the book right-side, a corresponding one of said at least two pages simultaneously flipping being said page displaying said content including said embedded advertisement, (the *flipping pages 603*, col. 17 line 43 and Fig. 6A), and

displaying a speed of browsing through the electronic book, the number of the at least two simultaneously moving pages is proportional to a variable flipping speed, and

the speed of browsing through the electronic book is proportional to the variable flipping speed.

8. Ho does not teach inserting an advertisement at a location within said content, said content now including said advertisement. Admitted as prior art (para. [0025]-[0029] and Fig. 14 of the published application, US 20040138952A1) is the insertion of an advertisement at a location within said content, said content now including said advertisement.

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9. Neither Ho nor the admitted prior art teach inserting said advertisement from a remote electronic archive. Treyz et al. teaches inserting an advertisement (*product/promotional information* embedded into a *recipe book*) from a remote electronic archive (col. 21 lines 18-23, col. 52 lines 23-37 and col. 54 lines 6-11). Because it enables ads to be drawn efficiently from anywhere reached by the Internet (col. 1 lines 10-14), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Treyz et al. to those of Ho et al, and the admitted prior art.
10. Ho also teaches claims 31-33 at the citations given above.
11. Ho also teaches the added limitations of the following dependent claims: 3, 5, 12 and 14 (col. 16 lines 5-6); claims 4 and 13 (Fig. 5A described at col. 15 lines 61-67); 7, 8, 16, 17 and 23, 24, and 26 (Figs. 6A & 6B, described at col. 17 line 3 to col. 18 line 10); claims 9, 18, 21 and 22, where a *bookmark* reads on an address indicator and a jump cursor (col. 12 lines 53-64 and col. 13 lines 42-50); claim 25 (col. 17 line 33); and claims 10, 19 and 27 (col. 1 line 29).
12. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being obvious in view of the references cited above and further in view of Sarra (US pat. 5,053,762). The references cited above do not teach a bending page. Sarra teaches a bending page (col. 2 line 48). Because Sarra teaches that this is a particularly appealing special effect (col. 1 lines 17-18), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add a the teachings of Sarra to those of the references cited in para. 14 above.

#### ***Allowable Subject Matter***

13. Claims 28-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
14. Applicant is cautioned that an allowance could not be considered until this or any other amendment was searched.

#### ***Response to Arguments***

15. Applicant's arguments filed with an amendment on 8 March 2007 have been fully considered but they are not persuasive.

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16. Applicant argues,

"Applicants' independent claims are amended to more distinctly claim Applicants' invention to clarify that the embedded advertisement is electronic content embedded within pre-existing content from a remote location. That is, the advertisement is something that is added after the original content is created and archived." (Page 13, end of 2<sup>nd</sup> para. from the bottom.)

First, the examiner sees nothing in the amended claims that can be interpreted as the ad being added after the original content is archived. It is claimed that the ad comes from a remote archive, but it is not claimed that the "content" is archived. Second, the simple process of writing reads on the claim: Someone writes something called "content", then next inserts an ad from a remote archive, then continues adding "content".

Third, it appears that applicant wants to claim inserting an ad into "finished content". But that limitation is taught by the new reference, Treyz et al. (col. 52 lines 23-25, where *the recipe* is taken to be finished content).

17. Applicant argues,

"However, contrary to the Official Action Figure 14 does not disclose or suggest inserting an advertisement as recited in Applicants' pending claims. Figure 14 is described in detail beginning on page 11 of Applicants' originally filed specification. Regarding the portion of Figure 14 directed to insertion of advertisement in Internet data transmission, Applicants' specification notes that technology has not yet been developed to allow insertion within content." (Pages 14-15, emphasis added)

First, the claims are not limited to "insertion of advertisement in Internet data transmission". Second, the statement referred to in the disclosure,

"Advertisement in Internet data transmission has not yet been developed even to the extent known in the delivery of movie/television content displays."

refers to movie/television content. For simpler ads, the statement is demonstrably false (Treyz et al., col. 1 lines 10-14 and col. 52 lines 23-37).

Applicant should appreciate that any promotion reads on an ad. As disclosed by applicant is discussing Fig. 14: "For example, an author can insert advertisements into the content that advertise him/herself (such as the self-aggrandizing statements commonly found in the

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autobiographies of sports figures) or others (such as a commercial company that has paid the author to "place" a product within a particular manuscript)." (sentence in the middle of para. [0028] of the published application, US 20040138952A1).

18. Applicant argues (p. 15, bottom) that this rejection should not be made final because "the pertinent passage of Ho was not explicitly identified in the Office action" [mailed 8 November 2006]. The previous and present (para. 8 above) Office action citations are to "para. [0025]-[0029] and Fig. 14 of the published application, US 20040138952A1". It is hardly unreasonable to ask applicant to read and understand five paragraphs of his own spec.

### **Conclusion**

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
22. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

24. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that “disposal or clarification for appeal may be accomplished with only nominal further consideration” (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.
25. Applicant may have after final arguments considered and amendments entered by filing an RCE.
26. **ABANDONMENT** – If examiner cannot by telephone verify applicant’s intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office’s web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

22 May 2007



DONALD L. CHAMPAGNE  
PRIMARY EXAMINER

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